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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,313	08/24/2001	Henry Yue	PF-0706 USN	4434
27904	7590	04/07/2004	EXAMINER	
INCYTE CORPORATION 3160 PORTER DRIVE PALO ALTO, CA 94304			BUGAISKY, GABRIELE E	
			ART UNIT	PAPER NUMBER

1653

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/744,313

**Applicant(s)**

YUE ET AL.

**Examiner**

Gabriele E. BUGAISKY

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9-17,19,22,25-30 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,9,10,13-17,19,22,25-30 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,5-7, 11-12, 35-40 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1003 .                      6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group II in the Paper No of . 10/2003 is acknowledged. The traversal is on the ground(s) that Applicants claims that unity of invention exists and there is a corresponding technical feature linking them.. This is not found persuasive because the Examiner cited prior art to show that there was no corresponding feature over the art as a whole. Applicants did not address this matter.

The Examiner thanks Applicants for pointing out typographical errors in the restriction requirement.. Group XII does contain claim 33. Claim 32 properly belongs to an additional Group, Group XIII drawn to a method of producing polypeptides of Group X. The requirement is still deemed proper and is therefore made FINAL.

Claims 1-2, 9-10, 13-17, 19, 22, 25-30, 32-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the paper of 10/2003.

This application contains claims 1-2, 9-10, 13-17, 19, 22, 25-30, and 32-34 are drawn to an invention nonelected with traverse.. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

The specification to which the oath or declaration is directed has not been adequately identified. See MPEP § 601.01(a). The title of the application on the declaration is different from that on the specification and other papers.

### ***Information Disclosure Statement***

Reference 13 has been crossed out as it is already of record. A reference may only be considered once.

### ***Specification***

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The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The use of trademarks (e.g., SEPHAROSE, PICOGREEN, SEPHADEX) has been noted in this application (pages 66, line 22, page 59 lines 24-25 and page 60, line 6, respectively.. They should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

Claims 11-12, 35 and 38 are objected to because of the following informalities: they read upon non-elected subject matter. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 3, 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what applicants consider to be “sorting nexin activity” Is it mere ability to bind a ligand, or is it endosomal transport activity or some other biological activity?

Claims 6-7 are included in this rejection as they depend from claim 3 and do not clarify the ambiguity.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 11, and 35-36 are rejected under 35 U.S.C. 102(a) as being indicated by TANAKA *et al.* The reference teaches isolated sequences of Hepatitis C virus. Nucleotides 74-93 of SEQ ID NO:29 of the reference are the RNA equivalent of a polynucleotide which has complete identity to nucleotides 54-73 of SEQ ID NO:3, and is thus deemed anticipatory for the

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recited subject matter of part e) of the claims. Amendment to recite identity over the full length of SEQ ID NO:3 would overcome this rejection.

Claims 3, 11-12, and 35-40 are rejected under 35 U.S.C. 102(b) as being indicated by MYERS. The reference teaches a human sequence tagged site G30543. Nucleotides 259-401 of the reference have complete identity to nucleotides 1324-1466 of SEQ ID NO:3, and thus encode amino acid residues of SEQ ID NO:1, G30543 is deemed anticipatory for the as it encodes a fragment of at least 10 contiguous amino acids of SEQ ID NO:1, as it comprises at least 60 nucleotides of SEQ ID NO:3, and as its complementary strand is complementary to SEQ ID NO:3.

Claims 3, 7, 11-12, and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Byatt *et al.* (US 20020137160) This published application has an earlier effective filing date than the instant application, and thus serves as prior art. Please note the attached sequence alignment of sequence 540 of the reference. It is 99.25% similar to encoded amino acids 205-337 of SEQ ID NO:1.

### ***Conclusion***

Claims 4-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

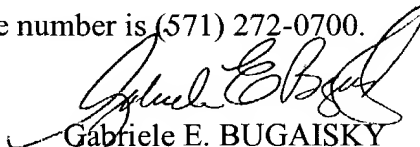
Gill *et al* describe the isolation and cloning of human sorting nexins 1 ad 2. They show that these proteins are involved in modulation of expression of cell surface receptors.

SEQ ID NO:922 of US patent 6569662 is 100% identical to nucleotides 147-1678 of instant SEQ ID NO:3 and it encoded aa 10-465 of instant SEQ ID NO:1; the Examiner has used Byatt *et al.* as a reference under 35 USC 102(e), as its effective filing date is prior to that of Tang *et al.* .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriele E. BUGAISKY whose telephone number is (571) 272-0945. The examiner can normally be reached on Tues.- Fri 8:15 AM-1: 45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher SF Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0700.

  
Gabriele E. BUGAISKY  
Primary Examiner  
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